

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 08/463,987  
Applicant: George Goicoechea et al.  
Filed: June 5, 1995  
Title: BIFURCATED ENDOLUMINAL PROSTHESIS  
T.C./A.U.: 3738  
Examiner: Michael J. Milano  
Confirmation No.: 9331  
Docket No.: BSI-210US

**COMMUNICATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REMARKS**

On November 26, 1997, the PTO mailed a Communication stating that all claims were allowable but that due to a potential interference, *ex parte* prosecution was suspended. The PAIR database refers to a Declaration of Interference dated April 23, 1998, which is believed to include Interference No. 104,192 that involved related Application No. 08/461,402. Applicants believe that *ex parte* prosecution was and had remained suspended pending the outcome of the review by the United States Court of Appeals for the Federal Circuit of Interference No. 104,192. Interference No. 104,192 is now terminated.

For part of the time that Interference No. 104,192 was pending, the '402 Application was also involved in Interference No. 104,083. Interference No. 104,083 is also terminated. Interference No. 104,192

The termination of Interference No. 104,192 is shown by the following documents, copies of which are attached for the Examiner's convenience:

- Final Decision and Judgment of the Board of Patent Appeals and Interferences dated July 21, 2001 Final Decision and Judgment ("Final Decision"), which includes the following orders:

"ORDERED that judgment as to the subject matter of the count is herein entered against junior party ERIC C. MARTIN and also against junior party ANDREW H. CRAGG and MICHAEL D. DAKE;

FURTHER ORDERED that the junior party ERIC C. MARTIN is not entitled to his patent claims 2-17 which correspond to the count;

FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count; and

FURTHER ORDERED that a copy of this paper shall be given a paper number and filed in the respective involved application/patent of the parties."

- Memorandum Opinion and Final Judgment of the United States District Court for the District of Columbia, Civil Action No. 01 CV 2015, dated March 31, 2006.
- Decision of the United States Court of Appeals for the Federal Circuit in *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, No. 2006-1434, dated August 8, 2007.

In the July 21, 2001 Final Decision, the Board granted Motion 12 of party Fogarty, which had requested the Board:

to deny the senior party [Cragg and Dake] the benefit of EP94400284.9 and EP94401306.9 on grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns. (quoted from Final Decision at p.2)

The Board also entered the following Order, among others:

It is . . . FURTHER ORDERED that junior party ANDREW H. CRAGG AND MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count. (Final Decision at p.69)

In the District Court proceeding, the stipulated issue to be resolved was:

Whether the Board erroneously affirmed its Grant of Fogarty *et al.* (Medtronic) Motion 12 in its July 27, 2001 Final Decision denying Cragg *et al.* (Scimed) benefit of the February 9, 1994 filing date of its European application no. 94400284.9 as a date of invention for the subject matter of the single count in Interference No. 104,192. (*Scimed Life Systems*, slip op. at p.7)

The District Court found that

the Board did not err in its granting party Fogarty's (Medtronic's) motion No. 12 which denied Cragg *et al.* (Scimed) the benefit of the earlier filing date of European application no. 94400284.9 and affirms the Board award of priority to Fogarty *et al.* (Medtronic) in its July 27, 2001 Final Decision and Judgment. (*Scimed Life Systems*, slip op. at p. 14).

In the August 8, 2007 Opinion, the Federal Circuit affirmed the decision of the U.S. District Court for the District of Columbia. *Boston Scientific Scimed*, slip op. at p.7.

#### Interference No. 104,083

The termination of Interference No. 104,083 is shown by the Judgment of the Board on March 10, 1999, a copy of which is submitted herewith. It includes the following orders:

"It is ORDERED that judgment as to the subject matter of count 1 is entered against junior party Martin and awarded in favor of senior party Cragg."

"It is ORDERED that Eric C. Martin is not entitled to a patent containing claim 1 of his involved patent, which corresponds to count 1."

"It is ORDERED that on this record, Andrew H. Cragg and Michael D. Dake are entitled to a patent containing their application claim 89 which corresponds to the count."

Those Interferences are now final, in that Applicants will not seek any further appeals. The Examiner is invited to consider the resolution of those Interferences.

Information Disclosure Statements Filed  
Before and After This Application Was In Suspense

Before this application was put into suspense, Applicants filed the following Information Disclosure Statement:

- Supplemental Information Disclosure Statement filed on August 28, 1997.

After this application was put into suspense on November 26, 1997, Applicants filed the following Information Disclosure Statements.

- Supplemental Information Disclosure Statement filed April 26, 2001.
- Supplemental Information Disclosure Statement filed August 18, 2004.

Applicants request that the PTO enter and consider all of the above Supplemental Information Disclosure Statements.

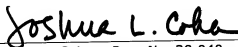
Supplemental Information Disclosure Statement And  
Amendment Filed Concurrently With This Communication

Concurrently with the filing of the present Communication, Applicants are filing an Amendment to the claims and a Supplemental Information Disclosure Statement. Applicants request that the PTO consider both of these additional filings.

Conclusion

For all of the above reasons, Applicants request confirmation that all Information Disclosure Statements (including the concurrently filed Supplemental Information Disclosure Statement) have been entered and considered. Applicants also request the return of this application to *ex parte* prosecution and the examination of the claims now pending in this application, as indicated in the concurrently filed Amendment.

Respectfully submitted,



Joshua L. Cohen, Reg. No. 38,040  
Stanley Weinberg, Reg. No. 25,276  
Attorneys for Applicants

JLC/SW/dhm

Enclosures: March 10, 1999 Judgment, Interference No. 104,083  
July 21, 2001 Final Decision and Judgment, Interference No. 104,192  
March 31, 2006 Memorandum Opinion and Final Judgment, U.S. District Court  
August 8, 2007 Opinion, U.S. Court of Appeals for the Federal Circuit

Dated: April 30, 2009

☒ P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

☐ P.O. Box 1596  
Wilmington, DE 19899  
(302) 778-2500

The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.